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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,657	12/20/2001	Donna M. Stemmer	014208.1395 (70-00-006)	5061
35005	7590	09/22/2006	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201			ROBINSON BOYCE, AKIBA K	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/029,657	<b>Applicant(s)</b> STEMMER ET AL.	
	<b>Examiner</b> Akiba K. Robinson-Boyce	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Due to communications filed 6/15/06, the following is a non-final office action. Claims 1-59 are pending in this application and have been rejected. Prosecution has been re-opened on this case. The previous rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

As per claims 1, 31, the limitations of these claims do not produce a useful, concrete and tangible result. In this case the variables of these claims aren't assigned to anything specific, thereby making the variables generic variables. In other words, these claims do not describe a specific substantial, or credible outcome, and are therefore not useful. In addition, these claims present no more than mathematical calculations, that assign values, and produce no real world aspect. These claims merely describe an algorithm, and are therefore not concrete/tangible. Therefore, claims 1, 31, and all claims that depend from them, (Claims 2-30, and 32-59 respectively), are therefore found to be non-statutory.

Art Unit: 3639

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 5, 11-19, 21, 23, 24, 26-28, 31-35, 41-48, 50, 52, 53, 55-57 under 35 U.S.C. 103(a) as being unpatentable over Sanders (US 6,411,936), and further in view of Ulwick (US 5,963,910).

As per claims 1, 31, Sanders discloses:

Identifying one or more intellectual capitals to be measured, wherein the intellectual capital comprises: human capital comprising one or more capabilities of one or more individuals associated with the enterprise, (Col. 17, line 44, shows human resource information as input);

Structural capital comprising experience and expertise of the enterprise embedded in one or more processes, policies, and systems associated with the enterprise, (col. 17, lines 46-47, expert information imported as input);

External capital comprising a value of one or more business relationships of the enterprise with one or more entities, (col. 15, lines 10-14, shows external trends as input related to strategy of enterprise);

Selecting a set of metrics that are present within the identified intellectual capitals, the set of metrics comprising one or more metrics present within the human capital, one or more metrics within the structural capital, and one or more metrics within

Art Unit: 3639

the external capital, wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics, (Col. 15, lines 4-8, each planning processor connected to a financial analyzer or finance database/a human resources database, (these represent the monetary/non-monetary metrics respectively), to provide updated information related to external and other inputs (such as human and structural inputs imported as shown in col. 13, lines 30-39, or in col. 17 as described in the above limitations as imported values). In this case, the set of metrics is represented by input values imported);

Assigning values to the set of selected metrics, (Col. 17, lines 54-61, computing an asset value of imported assets, and assigning attributes to the imported assets);

scaling the set of valued metrics, wherein the scaled non-monetary metrics and monetary metrics are operable to be mathematically associated, (Col. 17, lines 62-Col. 18, line 25, shows first and second set of metrics, where the direction of the movement of the a second set of metrics is a subset of the first set of metrics).

Sanders does not specifically disclose quantifying the identified intellectual capitals based on the scaled metrics, but does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33, and in order to have a solution, one must have specific values.

However, Ulwick discloses:

quantifying the identified intellectual capitals based on the scaled metrics, (col. 23, lines 55-63, shows quantification to ultimately yield a strategic option). Ulwick

Art Unit: 3639

discloses this limitation in an analogous art for the purpose of showing that quantification is used to generate strategic solutions.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to quantify the identified intellectual capitals based on the scaled metrics with the motivation of determining the specific value quantity of the intellectual capitals.

As per claims 2, 16, 32, 45, Sanders discloses:

Wherein the human capital is determined based on a plurality of parameters, including one or more of the following:

Training and education of the staff.../wherein the training and education of the staff is determined based on a plurality of metrics, including one or more of the following: education level per staff member...(Col. 12, line 23, training).

As per claim 11, Sanders discloses:

Further comprising defining the relationship between financial capital and the intellectual capital...(Col. 17, lines 62-Col. 18, line 25, shows first and second set of metrics, where the direction of the movement of the a second set of metrics is a subset of the first set of metrics).

As per claims 14, 43, Sanders discloses:

Wherein the competency information is determined based on a plurality of metrics, including one or more of the following: experience in a competency type; and experience of workforce..(Col. 20, line 33, relative experience).

As per claims 3, 33, Sanders discloses:

Wherein the structural capital comprises innovation capital and process capital, (Col. 3, lines 7-23, represented by the gross regarding organizational structures, and Col. 22, lines 22-29, represented by cost reduction through process improvements, also col. 2, lines 9-15, shows value enhancement includes gathering innovative ideas, w/ col. 17, line 37, shows processes received).

As per claims 4, 19, 34, 48, both Sanders and Ulwick fail to disclose the following:

Wherein the innovation capital is determined based on a plurality of parameters, including one or more of the following: Internal communications regarding inventions; External communications regarding the inventions; Patent protection; and Delivery to market of products or services embodying the inventions./wherein the patent protection regarding inventions is determined based on a plurality of metrics, including one or more of the following: number of patents owned; value of patents owned; and number of patents proposed:

Official notice is taken that it is old and well known in the art for the innovation capital to be determined based on a plurality of parameters, including Internal communications regarding inventions, external communications regarding the inventions, patent protection, and delivery to market of products or services embodying the inventions. It would have been obvious to one of ordinary skill in the art for the innovation capital to be determined based on a plurality of parameters, including Internal communications regarding inventions, external communications regarding the inventions, patent protection, and delivery to market of products or services embodying

Art Unit: 3639

the inventions with the motivation of gathering all of the necessary information needed to create and finance the invention.

As per claims 5, 35, Sanders discloses:

Wherein the process capital is determined based on a plurality of parameters including one or more of the following: business improvement, (Col. 15, lines 10-14, shows internal trends as input).

As per claims 12, 13, 41, 42, Sanders discloses:

Further comprising a radar diagram, wherein the radar diagram comprises: a plurality of scaled axes, wherein each scaled axis represents one of the metrics present in the intellectual capital; and a point on each axis to represent the quantified metric/wherein quantifying the identified intellectual capitals based on the scaled metrics comprises determining the total area enclosed in the radar diagram, (Col. 9, lines 10-22 w/ Fig. 4, represented by the multidimensional diagram).

As per claims 15, 17, 44, 46, Sanders discloses:

Wherein the performance of staff is determined based on a plurality of metrics, including one or more of the following: revenue generating staff/efficiency of organization.../wherein the usage of contractors is determined based on a plurality of metrics, including one or more of the following: revenue generating staff/efficiency of organization, (Col. 11, line 44-Col. 12, line 14, represented by the financial performance of firm).

As per claims 18, 47, Sanders discloses:



Wherein the internal communications regarding inventions is determined based on a plurality of metrics, including one or more of the following:

Usage of best practices, (Col. 10, lines 3-12, represented by best practices library).

As per claims 21, 50, Sanders discloses:

Wherein the delivery to market of products or services embodying the inventions is determined based on a plurality of metrics, including one or more of the following: investment in own research and development, (Col. 9, line 65, represented by research and development expenses).

As per claims 23, 52, Sanders discloses:

Wherein the business improvement is determined based on a plurality of metrics, including one or more of the following: improvement suggestions, (Col. 22, lines 12-24, represented by process improvements).

As per claims 24, 53, Sanders discloses:

Wherein the collaboration among staff is determined based on a plurality of metrics including one or more of the following: time saved by leveraging, (Col. 3, lines 19-24, represented by knowledge leveraged).

As per claims 26, 55, Sanders discloses:

Wherein the information sharing is determined based on a plurality of metrics, including one or more of the following: information availability for staff, (Col. 22, lines 56-60, integrated electronic document management system features).

As per claims 27, 56, Sanders discloses:

Art Unit: 3639

Wherein the capabilities of the customers is determined based on a plurality of metrics, including one or more of the following: delivery speed and quality, (Col. 1, line 64-Col. 2, line 19, desired speed when considering delivery).

As per claims 28, 57, Sanders discloses:

Wherein the capabilities of the customers is determined based on a plurality of metrics, including one or more of the following: number of organization enhancing customers...(Col. 1, lines 25-31, represented by corporations growing shareholder).

6. Claims 6-10, 20, 22, 25, 29, 30, 36-40, 49, 51, 54, 58, 59, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders (US 6,411,936) and further in view of Ulwick (US 5,963,910), and further in view of Eder (US 6,321,205).

As per claims 20, 49, neither Sanders nor Ulwick disclose the following, but Sanders does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Eder '205 discloses:

Wherein the external communications regarding inventions is determined based on a plurality of metrics, including one or more of the following: published internal achievements, (Col. 19, lines 55-61, represented by revenue). Eder '205 discloses this limitation in an analogous art for the purpose of showing that revenue achieved by the enterprise can be acknowledged.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the external communications regarding inventions to be

Art Unit: 3639

determined based on a plurality of metrics including published internal achievements with the motivation of selecting particular achievements to display to the public in order to positively represent the invention.

As per claims 22, 51, neither Sanders nor Ulwick disclose the following, but Sanders does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Eder '205 discloses:

Wherein the internal investment is determined based on a plurality of metrics, including one or more of the following:

Investment in internal structures, (Col 38, lines 37-46, represented by the expense component). Eder '205 discloses this limitation in an analogous art for the purpose of showing that expenses are taken into consideration when analyzing a business.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the internal investment to be determined based on a plurality of metrics including investment in internal structures with the motivation of incorporating unavoidable costs associated with the development process.

As per claims 25, 54, neither Sanders nor Ulwick disclose the following, but Sanders does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Eder '205 discloses:

Art Unit: 3639

Wherein the support tools for the staff is determined based on a plurality of metrics, including one or more of the following: wherein the support tools for the staff is determined based on a plurality of metrics, including one or more of the following: Tool availability for staff...(Col. 2, lines 50-52, represented by tools facilitating the analysis of information). Eder '205 discloses this limitation in an analogous art for the purpose of showing that specific tools are applied when analyzing a business.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the support tools for the staff to be determined based on tool availability for the staff with the motivation of guaranteeing that proper tools will be available upon request from a staff member.

As per claims 6, 36, neither Sanders nor Ulwick disclose the following, but Sanders does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Eder '205 discloses:

Wherein the external capital comprises supplier capital, customer capital, partner capital, and image in market, (Table 4 of Col. 10, represented by the Capital value attributed to loyal customers). Eder '205 discloses this limitation in an analogous art for the purpose of showing that customer capital is considered as part of business improvement program.

It would have been obvious to one of ordinary skill in the art at the time of the invention for the external capital to comprise customer capital with the motivation of including an accurate figure for external capital where customers are included.

As per claims 7, 9, 37, 39, Sanders fails to disclose the following, but does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Ulwick discloses:

Wherein the supplier capital/partner capital is determined based on a plurality of parameters including one or more of the following: customer satisfaction with suppliers/customer satisfaction with a partner, (Abstract, lines 10-13, satisfaction of each customer desired outcomes). Ulwick discloses this limitation in an analogous art for the purpose of showing that the quantification of customer desired outcomes can lead to strategic options which best satisfies the customer.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the supplier capital/partner capital to be determined based on a plurality of parameters including one or more of the following: customer satisfaction with suppliers/customer satisfaction with a partner with the motivation of showing that customer satisfaction is a key factor in determining the intellectual capital of an enterprise.

As per claims 10, 40 Sanders discloses the following:

Wherein the mage in market is determined based on a plurality of parameters including one or more of the following: market analysis ratings, (Col. 15-16, see Table 1).

As per claims 8, 38, Sanders discloses:

Wherein the customer capital is determined based on a plurality of parameters, including one or more of the following: relationships with the customers, (Col. 22, lines 20-24, represented by customer relationship).

As per claims 29, 58, Sanders discloses:

Wherein the relationships with the customers is determined based on a plurality of metrics, including one or more of the following: customer spend with business, (Col. 11, line 65-Col. 12 shows estimation of revenue based on customer visits).

As per claims 30, 59, Sanders fails to disclose the following, but does disclose the generation of value enhancement solutions ultimately based on imported data in col.18, lines 26-33.

However Ulwick discloses:

Wherein the satisfaction of the customers is determined based on a plurality of metrics, including one or more of the following: satisfied customer index, (Col. Abstract, liens 10-13, satisfaction). Ulwick discloses this limitation in an analogous art for the purpose of showing that metrics are used to predict the satisfaction of each customer desired outcome.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the satisfaction of the customers to be determined based on a satisfied customer index since this index actually represents and presents data for customers who are pleased.

### ***Response to Arguments***

Art Unit: 3639

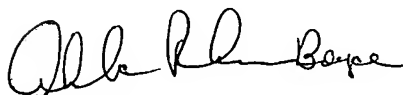
7. Applicant's arguments with respect to claims 1-59 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 8:30am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.

September 15, 2006



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER